

REMARKS

1. The Examiner has maintained their rejection of claims 1 and 4-6 under 35 U.S.C. §103(a) as being unpatentable over Irons, U.S. Patent No. 6, 192, 165. The Applicant respectfully traverses the Examiner's rejection of independent claim 1 in view of the amendment to independent claim 1 presented herein and the arguments presented in the prior response to Office Action and further in view of the arguments presented below. The Applicant has amended claim 1 to clarify that the service performed is on the "image representative of the document". The Applicant respectfully submits that this amendment adds no new matter since a similar limitation was found in pending claim 11 (i.e. the limitation "a service code specifying a service to be performed on said hardcopy document" (emphasis added)).

The Applicant respectfully submits that a fundamental difference between the invention claimed in amended claim 1 and the system described in Irons is that the claimed interface tag of the present application itself specifies the service to be performed on the document image (i.e. the "specified service"). The Applicant respectfully submits that providing information, such as disposition of a document or the document index, while it may be suggestive of an unspecified "future" service that could be performed based on the provided information (e.g. retrieval of a document based on the document index), it does not specify or suggest the actual service to be performed on the current instance of the image representative of the document.

The Applicant respectfully submits that Irons is void of any teaching or suggestion that any information that is provided on the tag may be used to specify a service to be performed on the document in which it is affixed. The Applicant

respectfully submits that the information provided on the tag described in Irons is either stored or used to facilitate storage (i.e. provides indexing information).

Thus, the Applicant respectfully submits that independent claim 1 fails to be rendered obvious by Irons and respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of claim 1.

The Applicant respectfully submits that dependent claims 4 -6 depend on and incorporate the limitations of independent claim 1, which is distinguishable over Irons as described above.

Further with respect to dependent claims 5 and 6, it is the Applicant's understanding that the Examiner has acknowledged that Irons does not specifically teach "extracting a service code" but has taken the position that Irons' teaching of "storing a code as an index (lined to a database for facilitating later retrieval of a document onto an output device, as well as a document invoice indicative of a service (Irons column 7, lines 55-61, Figures 8,9)" suggest provision of a service. The Applicant respectfully submits that merely providing information that may be used by a subsequent "service", e.g. retrieval of a stored document, would not teach or suggest provision of a service code identifying a specified service which is then performed on the stored document because there is no motivation to provide such a service code if the service is not going to be performed on the current image representative of the document.

Accordingly, the Applicant respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of dependent claims 4 -6.

2. The Examiner has rejected claims 2-3 under 35 U.S.C. §103(a) as being unpatentable over Irons as applied to claim 1 and further in view of the publication "Xerox tours DataGlyphs for paper data". The Applicant respectfully submits that dependent claims 2-3 depend on and incorporate the limitations of independent claim 1, which is distinguishable over Irons as described above. Accordingly, the Applicant respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of dependent claims 2-3.

3. The Examiner has rejected claims 11 and 14-15 under 35 U.S.C. §103(a) as being unpatentable over Irons, U.S. Patent No. 6, 192, 165 in view of Barton et al., U.S. Patent No. 5, 998, 752. The Applicant respectfully traverses the Examiners' rejection in view of the arguments presented with respect to independent claim 1 and the arguments presented below. It is the Applicant's understanding that the Examiner has taken the position that routing code taught in Barton suggests the claimed service code. As explained by the Examiner in the Final Office Action "[t]he routing code specifies a service to be performed on a mail item (i.e. a post card), since the routing code is used by the sorting system (and by a post office in general), to direct said mail item to a particular destination". The Applicant respectfully submits that the "routing code" of Barton is merely information that is used in performing the service itself, namely routing the mail item to the proper destination. The Applicant respectfully submits that the "service" is the routing and/or delivery of mail items and the routing code itself does not define or describe a service.

It is the Applicant's further understanding that the Examiner has explained as a motivation to combine Irons with Barton that "to apply Barton's routing code to Irons bar

code information, providing Irons the capability of mailing a printed copy of an invoice to a destination (Irons Figure 9) using a routing code". The Applicant has carefully reviewed Figure 9 and the accompanying descriptive text starting at col. 16, line 52 of Irons and respectfully submits that Irons is void of any suggestion of mailing an invoice. However, Irons does describe "e-mailing" (see col. 16, line 66), a copy of the invoice and the Applicant respectfully submits that such emailing teaches away from the Barton system which requires mailing a printed copy of the invoice.

Accordingly, as Barton does not teach the claimed "service code" and Irons "teaches away" from the use of the hardcopy mailing of Barton, the Applicant respectfully request that the Examiner withdraw their 35 U.S.C. §103(a) rejection of claims 11 and 14-15.

4. The Applicant respectfully traverses the finality of the rejection. The Applicant respectfully submits that the amendment did not necessitate a new search. The Applicant respectfully submits that the amendment of claim 11 incorporated subject matter of prior claim 8. Further, the element of performing a service specified in the service code was found in claim 1 (the claimed "specified service"). Thus, the Applicant respectfully submits that no new matter was introduced in the claims that necessitated a new search. The Applicant respectfully submits that since Barton was introduced as a new reference in the rejection of claims 11 and 14-15 the finality of the rejection was improper.

CONCLUSION

The Applicant respectfully submits that the foregoing amendments and arguments overcome the Examiner's various 35 U.S.C. §103(a) rejections and the Applicant respectfully respects that the Examiner grant allowance of all remaining pending and new claims.

In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call Attorney for Applicant(s), Richard B. Domingo at 650-812-4269.

Respectfully submitted,



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APPENDIX
Version With Markings to Show Changes Made

In the Claims:

1. (Amended) A method for processing a document based on information in a user interface tag, comprising the steps of:

scanning the document to produce an image representative of the document;
locating the user interface tag in the image;
decoding data represented in the user interface tag;
associating the data with a service and a user identity; and
performing the specified service on the image representative of the document.